

**REMARKS**

This responds to the Office Action mailed on October 11, 2006, and the references cited therewith.

Claim 33, 36 and 40 are amended, no claims are canceled, and no claims are added; as a result, claims 32-36 and 40 are now pending in this application.

**Double Patenting Rejection**

Claims 32-36 and 40 were rejected under the judicially created doctrine of double patenting over claims 16-39 of patent application 09/500,601(hereinafter “earlier application”) in view of Ross (U.S. Patent No. 6,195,447, hereinafter “Ross”).

Applicant respectfully traverses these grounds for rejection.

The Examiner has the burden to show that (1) the inventions claimed (2) are not patentably distinct and (3) are based on a *prima facie* showing of obviousness. This analysis must be based on what the claim defines and not on the claim language itself, as required by the Federal Circuit:

[I]t is important to bear in mind that comparison can be made only with what invention is *claimed* in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim *defines* and not looking to the claim language for anything that happens to be mentioned in it as though it were a prior art reference. ... [W]hat is claimed is what is *defined by the claim taken as a whole*, every claim limitation ... being material. *General Foods Corp. V. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ 2d, 1839, 1845 (Fed. Cir. 1992). (emphasis in original.)

Applicant respectfully submits that the Office Action has not made a *prima facie* case of judicially-created obviousness-type double patenting because the Examiner did not consider the earlier application claims as a whole. Instead, the Examiner picked certain elements of the earlier application claims to combine with Ross while ignoring other elements of the earlier application as if the earlier application claims were a prior art reference, which is expressly prohibited by the doctrine of non-statutory double patenting. For example, the Examiner ignored “*the sending at least one verification response, based upon the comparing of the first fingerprint*

*file against the second fingerprint file and upon the comparing of the first identification for the user against the second identification for the user*" element in the earlier application claims, which is absent in the present application claims. Therefore, Applicant respectfully submits that a *prima facie* case of judicially-created obviousness-type double patenting does not exist and it is requested that the rejection of claims 32-36 and 40 be withdrawn.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date 01/10/2007

By 

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10 day of January 2007.

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Signature